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# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,814	12/06/2000	Donald Kyle	332.1114	9564

7590

08/22/2003

Davidson Davidson & Kappel LLC  
485 Seventh Avenue 14th Floor  
New York, NY 10018

EXAMINER

BARTS, SAMUEL A

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 08/22/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/730,814

Applicant(s)

KYLE ET AL.

Examiner

Samuel A Barts

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-12, 14, 16, 23-25 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 11, 12, 14, 16, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

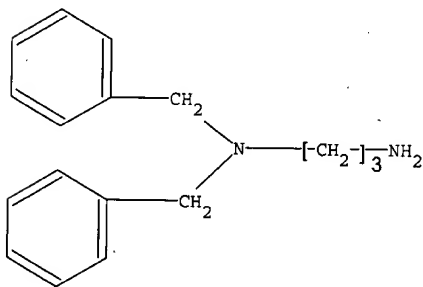
1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4-5, 7, 11-12, 14 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hoffmann et al (Journal of Medicinal Chemistry, 1975, Vol. 18, No.3, pages 278-284). See compound no 52 on page 280.

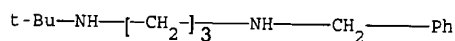
Hoffmann et al disclose the following compound:



This compound reads on the claims when  $R_4 = C_1$  alkyl,  $R_5 = 6$  membered aromatic group,  $R_1 = C_3$  alkyl,  $R_2 = R_3 = \text{hydrogen}$   $n = 0$ . Please note that the pharmaceutical composition claims read on the compound in solution. The HCL salt is disclosed which also reads on pharmaceutically acceptable salts. Also note that the reference contains other compounds that anticipate some of the claims. (For example compounds 53-55 on page 280)

3. Claims 1, 3-4, 7, 11-12, 14, 16 and 23-24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Guryn et al (Chem. Abstract 1976:43210, rn 57957-05-8 and 57957-20-7).

Guryn et al disclosed the following compound:



This compound reads on the claims when  $R_4 = \text{bond}$ ,  $R_5 = \text{hydrogen group}$ ,  $R_1 = C_3$  alkyl,  $R_2 = \text{hydrogen}$   $R_3 = C_4$  alkyl, and  $n = 0$ ; or when  $R_4 = \text{bond}$ ,  $R_5 = \text{hydrogen group}$ ,  $R_1 = C_3$  alkyl,  $R_3 = \text{hydrogen}$   $R_2 = C_4$  alkyl, and  $n = 0$ .

Please note that the pharmaceutical composition claims read on the compound in solution. The HCL salt is disclosed which also reads on pharmaceutically acceptable salts


*Allowable Subject Matter*

4. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel A Barts whose telephone number is 703-308-4630. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johan Richter can be reached on 308-1235. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
Samuel A Barts  
Primary Examiner  
Art Unit 1621

s.b.